

Application No. 10/657,837  
Amendment dated October 28, 2005  
Reply to Office Action of July 28, 2005

**REMARKS**

This Amendment and Response is presented in response to the Examiner's Final Office Action mailed on July 28, 2005. Claims 1, 2, 4, 5, 6, 8, 9, 11-18 are currently amended. Claims 23-29 are new. Claims 1-29 remain pending in the application. Claims 3, 7, 10, 20-22 remain withdrawn from consideration. Reconsideration is respectfully requested in view of the following remarks.

**Claims Rejections under 35 U.S.C. § 102**

The Examiner rejected claims 1, 2, 4-6, 12-19 under 35 U.S.C. §102(b) as being anticipated by Martin (US 6,132,464).

The Examiner's rejection states:

"Martin discloses a prosthesis to replace all or a portion of a natural facet joint on a vertebral body comprising: a fastening element adapted to be installed within the vertebral body at or near a pedicle and without support by a lamina and an artificial facet joint structure carried by the fastening element adapted and configured to replace all or a portion of natural facet joint. See figure 5 where the fastening element is the screw 18 and the facet joint structure are elements 1,2, 11 and 16."

Amended claim 1 recites :

A prosthesis to replace all or a portion of a natural facet joint on a vertebra,  
comprising:

- a fastening element adapted to be removably attached to the vertebra;
- a structure removably attached to the fastening element; and
- a prosthetic facet joint articulating surface removably attached to the structure.

Referring to figure 5 cited by the Examiner, the "facet joint elements" 1, 2, 11, and 16 identified by the Examiner are "linked to one support plate (7) with a sessile base (6, 16)" (Col. 3, line 67-Col. 4, line 1). The disclosure therefore lacks at least Applicant's claimed limitation for a

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prosthetic facet joint articulating surface provided for in currently amended claim 1. Furthermore, nothing in Martin discloses a prosthetic facet joint articulating surface removably attached to the structure as also claimed by Applicant.

In view of the above, Applicant requests that the rejection to claim 1 under 35 U.S.C. §102(b) as anticipated by Martin be withdrawn. Claim 2, 4-6, 12-19 depend from independent claim 1 and include the limitations thereof, and are therefore also not anticipated by Martin. Applicant thus requests that the rejection of dependent claims 2, 4-6, 12-19 also be withdrawn.

#### Claims Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 8, 9, 11 under 35 U.S.C. §103(a) as being unpatentable over Martin as applied to claim 1, and futher in view of Kaute (3,596, 656).

Currently amended claims 8, 9, 11 depend from independent claim 1, and include the limitations thereof. Claim 1 is currently amended and is allowable over Martin for at least the reasons above. Dependent claims 8, 9, and 11 depend from independent claim 1 and are thus patentable over Martin. The Examiner has not identified a suggestion or motivation to combine the teachings of Kaute and Martin. It would therefore not have been obvious to one of ordinary skill in the art to combine the teachings of these references.

Even if there is motivation to combine these references, such a combination would fail to make claims 8, 9, 11 obvious because neither reference teaches or suggests a prosthetic facet joint articulating surface that is removably attached to the structure as provided in currently amended claim 1. Claims 8, 9, and 11 depend from independent claim 1; are thus allowable. The applicant respectfully requests that the rejections to claims 8, 9, and 11 be withdrawn.

The Examiner has rejected claim 18 under § 103(a) as being unpatenable over Martin as applied to claim 1 above, and further in view of Karpman et al. (6,214,012).

Currently amended claim 18 depends from independent claim 1, and includes the limitations thereof. Claim 1 is currently amended and is allowable over Martin for at least the reasons above.

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Dependent claim 18 depends from independent claim 1 and is thus patentable over Martin. The Examiner has not identified a suggestion or motivation to combine the teachings of Karpman et al. and Martin to achieve the claimed invention. It would therefore not have been obvious to one of ordinary skill in the art to combine the teachings of these references.

Even if there is motivation to combine these references, such a combination would fail to make claim 18 obvious because neither reference teaches or suggests a prosthetic facet joint articulating surface that is removably attached to the structure, as required by currently amended claim 1. Claim 18, which depends from independent claim 1, is thus allowable. The applicant respectfully requests the rejection to claim 18 be withdrawn.

The Examiner has rejected claim 19 under § 103(a) as being unpatentable over Martin as applied to claim 1, and further in view of Eitenmuller et al. (5,108,399).

Rejected claim 19 depends from independent claim 1. Independent claim 1 is patentable over Martin for at least the reasons above. Dependent claim 19 depends from independent claim 1 and is thus patentable over Martin. The Examiner has not identified a suggestion or motivation to combine the teachings of Martin or Eitenmuller et al to achieve the claimed invention. It would therefore not have been obvious to one of ordinary skill in the art to combine the teachings of these references.

Even if there is some motivation to combine the teachings of Martin and Eitenmuller et al., such a combination would fail to render claim 19 obvious because any such combination would fail to teach or suggest a prosthetic facet joint articulating surface that is removably attached to the structure as provided in currently amended claim 1. Claim 1 is therefore allowable, as is dependent claim 19. As such, the rejection of claim 19 under § 103(a) should be withdrawn.

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**CONCLUSION**

In light of the remarks set forth above, Applicants believe that all rejections have been overcome and that all pending claims are in condition for allowance which is hereby requested.

Should the Examiner have any questions regarding this application, the Examiner is encouraged to telephone the undersigned. The Commissioner is authorized to charge any fees that may be required in connection with this submission, including petition fees and extension of time fees, and to credit any overpayments to Deposit Account No. 23-2415 (Attorney Docket No. 29914-701.406).

Respectfully submitted,

Date: 10/28/05

By:

  
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Thomas M. Zlogar  
Registration No. 55,760

WILSON SONSINI GOODRICH & ROSATI  
650 Page Mill Road  
Palo Alto, CA 94304-1050  
(650) 493-9300  
Client No. 021971